REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 4, 14, 24 and 33 are cancelled. Claims 1-3, 5-13, 15-23, 25-32 and 34-49 remain in this application and, as amended herein, are submitted for the Examiner's reconsideration.

Claims 1, 3, 11, 13, 21, 23, 31-32, 37-38 and 42-49 have been amended to place the application in condition for allowance. It is therefore submitted that this Amendment should be entered.

In the Office Action, claims 3, 13, 23, 32 and 38 were rejected under 35 U.S.C. § 112, first paragraph. The claims have been amended to recite that the distribution request e-mail message includes a predetermined *subject field*. Support for this change is found in paragraph [0033] of the specification.

The Examiner also rejected claims 3, 13, 23, 32, 36 and 38 under 35 U.S.C. § 112, second paragraph. Claims 3, 13, 23, 32 and 38 have been amended to call for a predetermined subject field which indicates that *the distribution request e-mail message includes the user request*. Further, the dependency of claim 36 has been amended to provide proper antecedent basis.

It is therefore submitted that claims 3, 13, 23, 32, 36 and 38 are in full compliance with the requirements of 35 U.S.C. § 112.

The Examiner also raised various art rejections:

I. Claims 1, 11, 21, 31 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,721,829) in view of Abecassis (U.S. Patent Application Publication No. 2001/0041053) and Sartain (U.S. Patent No. 5,914,712). It is submitted, however, that the claims are patentably distinguishable over the references.

The Dunn patent is concerned with an interactive

television system. A centralized headend server stores programs and program previews in independent data files and locates and retrieves desired programs from the data files in response to user requests sent from a set-top box located in a subscriber home. To order a program, the user selects the video-on-demand channel, views one or more previews on a television screen, and actuates an icon on the screen that causes the set-top box to send a message to the headend. The message contains a descriptor such as an ID or a moniker of the program, and the headend uses the descriptor to access and retrieve the requested program and then transmits the program to the set-top box for display on the user's television screen. (See Figs. 1, 3 and 5; col. 3, lines 43-55; col. 4, lines 8-9 and 36-46; col. 5, lines 8-40; and col. 7, lines 20-42). Dunn thus describes that a request containing a specific descriptor is sent to the headend and that the request is initiated by actuating an order icon located on a user interface screen. The patent does not disclose or suggest a user request in a freestyle text format, as acknowledged by the Examiner, and does not disclose or suggest an e-mail message. Therefore, Dunn does not disclose or suggest converting a freestyle text format user request into a distribution request e-mail message that includes the user request and that is *addressed to a distribution controller of a transmitter*.

The Abecassis publication describes that a user request for content-on-demand video programs is analyzed by the video provider using, e.g., a keyword search and retrieval. (See ¶¶ [0311]-[0312] and [0315]). Abecassis, however, is not concerned with sending e-mail messages and therefore does not disclose or suggest converting a user request into a distribution request e-mail message that includes the user request and that is *addressed to a distribution controller of the transmitter*.

The Examiner relies on the Sartain patent as teaching a video-on-demand system wherein distribution requests are made via e-mail. Sartain, however, describes a system in which subscriber selections of video programs are relayed over the Internet to an *accounting service* using, e.g., an e-mail address. (See Figs. 3 and 5; col. 6, lines 39-41; col. 7, lines 4-12; and col. 10, lines 15-20). The e-mail message is addressed to the *accounting service* rather than being addressed to the headend that sends the selected programs to the subscriber's television. Thus, Sartain does not disclose a distribution request e-mail message *addressed to a distribution controller of a transmitter.* Moreover, the subscriber selections and a credit card number are sent through the *accounting service* so that the subscriber's credit card number can be charged. (See col. 10, lines 20-24). The patent therefore provides motivation for sending the subscriber selections over an indirect path via the accounting service and does not provide any incentive for sending the selections over a more direct path, such as to a distribution controller of a transmitter. It follows that Sartain does not disclose or suggest converting a user request in an e-mail message that includes the user request and that is addressed to *a distribution controller of a transmitter.*

Neither Dunn, Abecassis nor Sartain suggests:

> said receiver being operable to accept a user request for a desired program, the user request being in a free style text format, to convert the user request into a distribution request e-mail message that includes the user request and that is addressed to a distribution controller of said transmitter, and to send the distribution request e-mail message to said transmitter

as recited in claim 1.

Moreover, a person of ordinary skill in the relevant art would not find any motivation in either Dunn, Abecassis or

Sartain to combine their respective teachings in the manner asserted by the Examiner. Though the references could be considered to address similar problems, namely, how to carry out the selection and distribution of video programs, this similarity merely indicates that the references could be within the scope of the art considered by the ordinary practitioner under 35 U.S.C. § 103. See M.P.E.P. § 2141.01(a). However, the separate requirement of establishing motivation for the ordinary practitioner to combine the features taught by the references is not met here. Rather, each of the references merely provides an alternative solution to the problem. Specifically, Dunn provides a user interface screen by which the user actuates an order icon to send a descriptor, Abecassis provides keyword searching and retrieval, and Sartain provides the sending of a program identification number and a credit card number to an accounting service over the Internet through, e.g., an e-mail address. Even if the references were taken in combination, the combination would only suggest that any of the above solutions would work by itself. Nothing in any of the references suggests that a beneficial result would come about by attempting to combine the bits and pieces of the references. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01. Because the ordinary practitioner would not find motivation in either Dunn, Abecassis or Sartain to combine their teachings to convert a user request in a freestyle text format into a distribution request e-mail message that includes the user request, the asserted combination of the references is not obvious.

It follows that neither Dunn, Abecassis nor Sartain, whether taken alone or in combination, discloses or suggests the system called for in claim 1, and therefore claim 1 is

patentably distinct and unobvious over the references.

Claim 11 is directed to a method of distributing programs and calls for:

> receiving, at a transmitter, a distribution request e-mail message from a receiver, the distribution request e-mail message being addressed to a distribution controller of the transmitter and including a user request for a desired program, the user request being in a free style text format[.]

For the reasons set out above, neither Dunn, Abecassis nor Sartain, whether taken alone or in combination, suggests receiving a distribution request e-mail message that is *addressed to a distribution controller of a transmitter* and includes a user request. Claim 11 is therefore patentably distinct and unobvious over the references at least for the same reasons.

Claim 21 defines a transmitter that includes:

> a distribution controller operable to receive a distribution request e-mail message addressed to said distribution controller from a receiver, the distribution request e-mail message including a user request for a desired program, the user request being in a free style text format, to determine whether the requested program is one of the stored plurality of distributable programs, and to read out the requested program from said distributable program storing unit when the requested program is one of the stored plurality of distributable programs[.]

Claim 21 therefore includes limitations similar to those recited in claim 11 and is also distinguishable over the cited references for at least the same reasons.

Claim 31 is directed to a receiver having a controller that is operable in a manner similar to the receiver defined in claim 1. Therefore, claim 31 is distinguishable over the cited art at least for the same reasons.

Claim 37 is directed to a method of receiving programs and calls for converting an e-mail message into a distribution

request having limitations similar to those described above. Therefore, at least for the same reasons, claim 37 is also distinguishable over the references.

II. Claims 2, 12 and 22 were rejected under 35 U.S.C. § 103 as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 1, 11 and 21 above and further in view of Yurt (U.S. Patent No. 5,550,863). It is submitted, however, that the claims are patentably distinguishable over the references.

Claim 2 depends from claim 1, claim 12 depends from claim 11, and claim 22 depends from claim 21. Therefore, claims 2, 12 and 22 are each distinguishable over Dunn, Abecassis and Sartain at least for the same reasons.

The Yurt patent describes an audio and video transmission system in which a user accesses an item in a source material library by (i) dialing a system access number and then entering the identification code of the item or (ii) logging onto a user interface and then providing an identification code, a title or other known facts of the item. (See Figs. 3 and 4; col. 11, lines 1-7; col. 13, lines 37-58; and col. 14, lines 34-51). Yurt does not disclose or suggest converting a user request into a distribution request e-mail message that includes the user request and that is *addressed to a distribution controller of a transmitter*, and Yurt does not disclose or suggest receiving such an e-mail message. Yurt therefore does not remedy the above-described deficiencies of Dunn, Abecassis and Sartain regarding claims 1, 11 and 21.

III. Claims 5, 7, 15, 17, 25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 1, 11 and 21 and further in view of Yurt and Venkatraman (U.S. Patent No. 6,477,647). It is submitted, however, that the claims are patentably distinguishable over these references.

Claims 5 and 7 depend from claim 1, claims 15 and 17

depend from claim 11, and claims 25 and 27 depend from claim 21. Therefore, each of the claims is distinguishable over Dunn, Abecassis and Sartain for at least the same reasons. Additionally, Yurt does not address the deficiencies of these references at least for the reasons described above in response to the rejection of claims 2, 12 and 22.

The Venkatraman patent describes an on-line trading system where, after completing a trade, the customer may opt to receive a confirmation e-mail message. The customer can open and view the message, and when the customer closes the message, a return receipt is transmitted to the trading system. (See Figs. 3, 4 and 6; col. 2, line 64 - col. 3, line 10; col. 6, lines 8-23 and 39-54; and col. 7, line 27 - col. 8, line 18). The patent does not disclose or suggest converting a user request into a distribution request e-mail message that includes the user request and that is *addressed to a distribution controller of a transmitter*, and the patent does not disclose or suggest receiving such an e-mail message. Therefore, Venkatraman does not remedy the above-noted deficiencies of Dunn, Abecassis, Sartain and Yurt regarding claims 1, 11 and 21.

IV. Claims 6, 8, 16, 18, 26 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain and Yurt as applied to claims 2, 12 and 22 and further in view of Venkatraman. It is submitted that the claims are patentably distinguishable over the cited art.

Claims 6 and 8 depend from claim 1, claims 16 and 18 depend from claim 11, and claims 26 and 28 depend from claim 22. Therefore, each of claims 6, 8, 16, 18, 26 and 28 are distinguishable over Dunn, Abecassis, Sartain, Yurt and Venkatraman for at least the same reasons set out above.

V. Claims 9-10, 19-20, 29-30 and 42-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Yurt and Venkatraman as applied to claims 5-

6, 15-16 and 25-26 and further in view of Lawler (U.S. Patent No. 5,805,763). It is submitted, however, that the claims are patentably distinguishable over the cited references.

Claims 9-10 and 42-43 depend from claim 1, claims 19-20 and 44-45 depend from claim 11, and claims 29-30 and 46-47 depend from claim 21. Therefore, each of claims 9-10, 19-20, 29-30 and 42-47 are distinguishable over Dunn, Abecassis, Sartain, Yurt and Venkatraman at least for the reasons described above regarding claims 1, 11 and 21.

The Lawler patent describes an interactive viewing system in which a user selects programs for display or for future recording. The programs are selected from a menu that is generated by an interactive station controller located at the user's station and shown on a display screen. The selection of a program causes the interactive station controller to either tune to the program, set a reminder tag, or set a record tag that may be stored locally or sent to a headend. (See Figs. 2, 4A-4B, 6 and 7; col. 7, lines 19-28; col. 8, lines 12-17; col. 10, lines 30-64; col. 11, lines 7-31; and col. 11, line 45 - col. 13, line 12). The patent, however, does not disclose or suggest converting a user request into a distribution request e-mail message that includes the user request and that is *addressed to a distribution controller of a transmitter*, and the patent does not disclose or suggest receiving such a message. Therefore, Lawler does not remedy the deficiencies of Dunn, Abecassis, Sartain, Yurt or Venkatraman regarding claims 1, 11 and 21 as described above.

Also, the Examiner contends that Lawler teaches a video-on-demand service that *automatically instructs* a recorder connected to a receiver to record a selected program by transmitting a control command to the receiver. However, Lawler merely describes that a user can set a record tag by activating a "Record" button in a future program options menu on the

display screen and that the interactive station controller may send the record tag to the headend. The headend subsequently "informs" the interactive station controller when a program having an associated record tag is available, and *the interactive station controller* then *controls the recording device* to record the associated program. Alternatively, the recording device is *associated with the headend* so that the recorded program *is stored at the headend* for later retrieval. (See col. 13, lines 8-35). Lawler describes that the headend merely *informs the controller* and does not disclose or suggest that a *command* is sent. Therefore, the patent does not disclose or suggest an answer e-mail message in which supplemental information includes a *control command* for causing a recorder connected to a receiver to record the requested program, as defined in claims 9-10, 19-20 or 29-30.

The Examiner also contends that Yurt discloses an answer e-mail message having supplemental information that includes the time of a program and the price of a program, and the Examiner refers to col. 13, line 55 - col. 14, line 12 of Yurt. The patent, however, does not disclose or suggest that the supplemental information includes *cryptanalytic information* for decrypting the program or includes *accounting information* for the program, as called for in claims 42-47.

VI. Claims 34 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 31 and 37 and further in view of Venkatraman. It is submitted, however, that the claims are patentably distinguishable over the cited art.

Claim 34 depends from claim 31 and claim 39 depends from claim 37. Therefore, claims 34 and 39 are each distinguishable over Dunn, Abecassis and Sartain at least for the reasons set out above regarding claims 31 and 37. Additionally, claims 31 and 37 include limitations similar to

those of claims 1, 11 and 21, as described above, and therefore Venkatraman does not address the deficiencies of these references for at least the same reasons.

VII. Claims 35 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain and Venkatraman as applied to claims 34 and 39 and further in view of Yurt. It is submitted, however, that the claims are patentably distinguishable over the cited references.

Claim 35 depends from claim 31, and claim 40 depends from claim 37. Claims 35 and 40 are therefore distinguishable over Dunn, Abecassis, Sartain and Venkatraman for at least the reasons described above with regards to claims 31 and 37. Also, as noted above, claims 31 and 37 include similar limitations to those set out in claims 1, 11 and 21, and thus Yurt does not remedy these deficiencies at least for the same reasons.

VIII. Claims 36 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis and Sartain as applied to claims 31 and 37 and further in view of Lawler. However, it is submitted that the claims are patentably distinguishable over the cited art.

Claim 36 depends from claim 31, and claim 41 depends from claim 37. Each of claims 36 and 41 are therefore distinguishable over Dunn, Abecassis and Sartain at least for the same reasons. Moreover, claims 31 and 37 include limitations similar to those of claims 1, 11 and 21, as described above, and therefore Lawler does not remedy these deficiencies at least for the same reasons.

Additionally, claims 36 and 41 each include limitations similar to those set out in claims 9-10, 19-20 and 29-30. Therefore, claims 36 and 41 are further distinguishable over Lawler at least for the same reasons.

IX. Claims 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain and

Lawler as applied to claims 36 and 41 and further in view of Yurt. However, it is submitted that the claims are patentably distinguishable over the references.

Claim 48 depends from claim 31 and claim 49 depends from claim 37. Therefore, claims 48 and 49 are each distinguishable over Dunn, Abecassis, Sartain, Lawler and Yurt for at least the reasons set out above.

Moreover, claims 48 and 49 include limitations similar to those set out in claims 42-47 and are further distinguishable over Yurt at least for the same reasons.

Accordingly, the withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By _____

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